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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/254,344 | 09/03/1999 | YOSHIHIDE HAYASHIZAKI | 024705-077 | 6838 |

7590

11/08/2002

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| EXAMINER |
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HUTSON, RICHARD G

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| ART UNIT | PAPER NUMBER |
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1652

DATE MAILED: 11/08/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/254,344

Applicant(s)

HAYASHIZAKI ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 11,13,14,18,20 and 22.

Claim(s) objected to: 4,5,26 and 27.

Claim(s) rejected: 1,3,7-10,12,15,17,19,21,23,25 and 28.

Claim(s) withdrawn from consideration: 24.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



RICHARD HUTSON, PH.D.
PATENT EXAMINER

Part of Paper No. 21

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Continuation of 2. NOTE: Applicants proposed amendment of claims 10 and 28 such that each of these claims are drawn to "An RNA polymerase comprising a wild-type RNA polymerase..." introduces new issues that would require additional consideration and search. It is acknowledged that applicants are proposing this amendment as a means of overcoming the previous 112 second paragraph rejection of claims 10 and 28, but applicants proposed amendment increases the scope of the claimed polymerases, by changing the transitional phrase of the independent claim from which the claims depend from "consisting" to "comprising". Such an amendment would introduce new 112 second paragraph rejections and require a new search. Applicants attention is drawn to the previous office action, page 6, lines 12-14, wherein it is stated that these claims are interpreted (and searched) based on the interpretation that the additionally claimed mutations of the modified polymerases must be within the defined region.

Continuation of 5. does NOT place the application in condition for allowance because: all of the rejections of record remain based on the non-entry of applicants amendment.